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Reply to Office action of June 17, 2010

REMARKS/ARGUMENTS

In the Office action dated June 17, 2010, the Examiner rejected claims 1, 2, 4, 9-17, 19 and 22-29 under 35 U.S.C. §103(a) as allegedly obvious over Cox, et al. (U.S. Patent No. 6,161,543) in view of Whayne, et al. (U.S. Patent No. 6,203,525) and Fleischman (U.S. Patent No. 5,885,278). In making this rejection, the Examiner continues to assert that Cox discloses a non-conductive tubing having "a pre-formed generally heel-shaped curve comprising a first bend away from the axis of the catheter body and a second bend back toward and past the axis of the catheter body and terminat[ing] in a generally straight distal end which end is generally transverse to the axis of the catheter body." Office action, pages 2-3. In addition, the Examiner appears to rely on disclosure in Cox of a "right angle probe" in maintaining that Cox discloses the recited heel-shaped curve. Applicant respectfully traverses.

Although the Examiner continues to assert that Cox discloses a tubing having a pre-formed curve comprising a first bend away from the axis of the catheter body and a second bend back toward and past the axis of the catheter body, Cox nowhere teaches or suggests such a configuration. Notably, the Examiner points to no particular section or excerpt in Cox that discloses or suggests the recited first and second bends. While the Examiner appears to rely on some disclosure in Cox regarding a "right angle probe," those probes are described and depicted as having an elbow portion between the elongated shaft and the ablating end. Column 18, lines 3-8; Figure 24. While the right angle probe may include an elbow portion creating a right angle between the ablating end and the elongated shaft, Cox nowhere describes, teaches or suggests that the elbow portion includes a *first bend away* from the axis of the catheter body and a *second bend distal the first bend* back toward and past the axis of the catheter body, as presently claimed. Indeed, Cox appears to disclose only a *single* bend in the right angle probe. As such, Cox fails to teach or suggest the generally heel-shaped curve recited in the present claims.

Moreover, the Examiner argues that Fleischman discloses "an elongated member 22 having a first bend away from the central longitudinal axis and a second more distally place bend which allows for the generally straight distal end of the elongated member to cross the first

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central axis at about a right angle in order to provide the ablating elongated member with the proper shape that corresponds to the tissue surface. Office action, page 4 (citing Fleischman Figures 17 and 19). However, Fleischman nowhere teaches or suggests a tubing having a *pre-formed* curve that terminates in a *generally straight* distal end. Quite to the contrary, Fleischman appears to disclose loop or half-loop structures that can be extended and distended by a central stylet. Indeed, column 3, line 66 through column 4, line 8, Fleischman specifically describes the structures depicted in Figures 17 through 19, which the Examiner relies upon in making this rejection. In particular, Fleischman states that "FIG. 17 is a plan view of a *half-loop structure* for supporting *multiple electrode elements* having an associated *center stylet* attached to a remote control knob for movement *to extend and distend the half-loop structure.*" Column 3, line 66 through column 4, line 2. Additionally, Figures 18 and 19 are depictions of the same half-loop structure of Figure 17, but Figure 18 depicts the structure in an extended position while Figure 19 depicts the structure in a distended position. Column 4, lines 3-8. As such, the half-loop structures in Figures 17-19 of Fleishman are not *pre-formed*, as presently claimed.

Also, as the structures in Fleishman are half-loop structures, they do not include a generally straight distal end, let alone a tubing with a second bend back toward *and past* the first central longitudinal axis of the catheter body, as presently claimed. In fact, as the distal-most portion of the half-loop structure of Fleishman is connected to the center stylet, no portion of that structure extends *past* the first central longitudinal axis. *See Figures 17-19 (depicting the half loop structures entirely on one side of the central stylet).*

The Examiner argues that it would have obvious, based on the teachings in Fleischman, to modify the device of Cox and Whayne to provide "an elongated member having a first bend away from the central longitudinal axis and a second more distally placed bend which allows for the generally straight distal end of the elongated member to cross the first central longitudinal axis at about a right angle in order to provide the ablating elongated member with the proper shape that corresponds to the tissue surface." Office action, page 4-5. However, as discussed above, Fleischman nowhere teaches or suggests a generally straight distal end or a *pre-formed* curve having the recited first and second bends. Indeed, Fleischman fails to teach or suggest an

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elongated ablating member, as suggested by the Examiner. In complete contrast to the right angle probe disclosed in Cox, Fleischman discloses loop and half-loop structures. Accordingly, even if one of ordinary skill in the art were inclined to find a way to combine these references (which Applicant does not concede), any such combination would not result in a *pre-formed* generally heel-shaped shaped curve comprising a first bend away from the first central longitudinal axis of the catheter body, and a second bend distal the first bend back toward and past the central longitudinal axis of the catheter body.

Notwithstanding the failure of the combination of Cox, Whayne and Fleischman to disclose the recited pre-formed generally heel shaped curve, Applicant has amended independent claims 1 and 17 in an effort to expedite allowance of this application. In particular, Applicant has amended claims 1 and 17 to recite that the generally straight distal end has a free distal end. As the structures in Fleischman do no have free distal ends (i.e., Fleishman discloses loop and half-loop structures that do not include any free distal end), amended independent claims 1 and 17, and all claims dependent therefrom, including claims 2, 4, 9-16, 19 and 22-29, are allowable over Cox, Whayne and Fleischman.

Applicant notes that in his response to Applicant's previous arguments, the Examiner states that "[i]t would have been an obvious matter of design choice to make the different portions of the curved distal end of the elongated member of whatever form or shape was desired or expedient," and that "[a] change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results." Office action, page 9 (citing *In re Dailey et al.*, 149 USPQ 47) ("*Dailey*"). However, neither *Dailey* nor its corresponding section of the MPEP provides support for the Examiner's contention that any change in form or shape is "generally" recognized as unpatentable. Indeed, the relevant section of the MPEP, i.e., §2144.04, informs Examiner's that "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court."

In the present case, the facts of *Dailey* are not "sufficiently similar" to those of the present application. In particular, in *Dailey*, the invention at issue was a nursing bottle for delivering

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formula to a baby. There were two points of differentiation over the prior art: 1) the shape of the slit in the nipple for delivering the formula; and 2) the shape of the collapsible portion. In discussing the shape of the slit in the nipple, the court noted that the particular slit shape was disclosed in a prior art reference and that it would have been obvious to incorporate that slit configuration into the bottle disclosed in another reference. With respect to the shape of the collapsible portion, the court noted that Appellants presented no arguments that the particular configuration (i.e., a less than hemisphere configuration) was significant. The court concluded that absent such an argument, the configuration was nothing more than "one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of [the cited reference]." *Dailey*, 149 USPQ 47, 50 (CCPA 1966). Notably, *Dailey* nowhere states or implies that a showing of unexpected results would have been required to overcome the obviousness rejection, nor does *Dailey* state or imply that all changes in shape or form would be obvious.

In significant contrast to *Dailey*, the present application gives a detailed explanation of the function and importance of the claimed pre-formed generally heel-shaped curve. In particular, at page 5, lines 25-32, the specification states,

"This 'foot' or 'heel' shape is particularly suitable for ablating a linear lesion with the porous electrode 38 due to its inherent stability. Specifically, it limits the electrode roll when longitudinal push forces are applied to the catheter body, particularly when the porous electrode is placed against the uneven contours of the heart wall. Thus, when the user exerts a longitudinal force on the catheter body, the entire length of the porous electrode tends to exert a force on the tissue rather than the proximal end of the porous electrode being pushed into the tissue and the distal end of the porous electrode being forced away from the tissue."

Given this detailed explanation of the importance and significance of the shape recited in the present claims, the facts of *Dailey* are not relevant, and the Examiner's reliance on that case is misplaced.

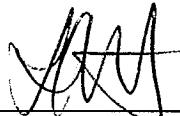
The Examiner also rejected claims 30-32 under 35 U.S.C. §103(a) as allegedly obvious over Cox, Whayne and Fleischman in view of one or more of Fung, et al. (U.S. Patent No. 6,120,476) and Swanson, et al. (U.S. Patent No. 5,961,513). However, each of claims 30-32

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depend from one of independent claims 1 and 17, both of which are allowable over Cox, Whayne and Fleischman, as discussed above. Neither Fung nor Swanson remedy the deficiencies of Cox, Whayne and Fleischman as neither reference teaches or suggests the catheters recited in independent claims 1 and 17. Therefore, independent claims 1 and 17, and all claims dependent therefrom, including claims 30-32, are allowable over Cox, Whayne, Fleischman, Fung and Swanson.

Claims 1, 2, 4, 9-17, 19 and 22-32 now remain pending in this application. By this amendment, Applicant has amended claims 1 and 17 to place the claims in condition for allowance and to place the claims in better form for appeal. The amendments find full support in the original specification, claims and drawings, and no new matter is presented. In view of the above amendments and remarks, Applicant submits that all of pending claims 1, 2, 4, 9-17, 19 and 22-32 are in condition for allowance. Applicant therefore respectfully requests a timely indication of allowance. However, if there are any remaining issues that can be addressed by telephone, Applicant invites the Examiner to contact Applicant's counsel at the number indicated below.

Respectfully submitted,
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